

REMARKS/ARGUMENTS

This is an amendment after final rejection under 37 U.S.C. section 1.116. Claims 1, 5-15 and 31-35 are pending in the application and have been finally rejected. Claims 4 and 34-35 have been cancelled. Claims 1 and 9 are currently amended. Applicant respectfully requests that the amendment be entered to place the application in better form for appeal.

The Office Action objected to the amendment of September 14, 2004 under 35 U.S.C. section 132(a) on grounds that it attempted to introduce new matter into the disclosure by reason of an amendment incorporating U.S. Patent Nos. 6,408,321 and 6,349,265 by reference. Applicant respectfully traverses this objection. The originally-filed specification incorporated by reference U.S. Patent Applications having attorney dockets YOR999-149 and YOR999-150. Those patent applications, respectively, issued as U.S. Patent Nos. 6,408,321 and 6,349,265. Therefore, the amendment substituting the patent numbers for the application docket numbers was appropriate.

The Office Action advised Applicant to submit a new abstract alone in a separate piece of paper. Therefore, Applicant has complied with this request.

The Office Action rejected claims 8, 9, and 12-14 under 35 U.S.C. section 112, second paragraph, as being indefinite. With respect to claim 8, the Examiner contends that the claim is unclear as to what parameters are represented by variable \hat{w}^T in solving for $f(\hat{w})$. The Examiner further rejected claim 8 for its use of the language "based upon" for characterizing C. Applicant respectfully traverses this rejection of claim 8. First, \hat{w} is defined as "some vector" and T as a transpose. These terms are well known to those skilled in the art. Clearly, the term \hat{w}^T can only mean a transpose of the vector \hat{w} . Second, the use of "based upon" does not render the claim indefinite. The word "based" is a form of the word "base" and Webster's New Collegiate Dictionary, C&M Merriam Company (1973) defines "base" as to find a base for or basis for – usu. Used with upon or on." The words "based upon" are commonly used and have even been used in issued U.S. Patents such as U.S. Patent 6,934,953 (claim 16). Because patents are presumed valid, we must presume that the use of the words "based upon" *per se* does not result in indefiniteness and the Office Action has not shown why in this case they would. In fact, the term is used in a very similar sense in Patent 6,934,953. The rejection of claim 9 is also overcome for the foregoing reasons.

With respect to claim 12, the rejection was made on the basis of the use of the word "represents" as indefinite. Applicant reiterates the arguments made in prior amendments and briefs on this issue. In addition, Applicant further contends that, as in the case of "based upon", the word "represents" does not render claim 12 as indefinite. The word has appeared in a similar context in U.S. Patent 6,934,940. In responding to Applicant's argument, the Examiner concludes that the Applicant's is not persuasive because "x" is not present in claims 8, 9, or 12. The Examiner misapprehends Applicant's argument. Applicant did not argue that a variable x was used in any of those claims. Rather Applicant stated: "In the context of a mathematical equation, as in claim 12 and claims 8-9, the phrase "'x' represents a value" simply means that the given variable or symbol represents another value or concept." (emphasis added). That does not mean that x is found in any of those claims.

The Office Action rejected claims 1, 4-15 and 31-35 as failing to comply with the written description requirement. Applicant respectfully traverses this rejection. With respect to claim 1, the Office Action contends that there is no written description for the language "based on reselected criteria." Applicant maintains its prior traversals of this conclusion. The specification supports this claim language because those skilled in the art would appreciate that applicant possessed the claimed invention. Moreover, Applicant is amending claim 1 to make it clearer that the criteria are association criteria. This amendment makes it clearer that these criteria are preselected. More specifically, the criteria are selected during the training phase which is logically prior to applying a mapping. See for example, page 36, lines 12-25, and page 40, lines 17-22. These sections discuss the criteria pre-selection during the training phase. A review of the entire processes disclosed by the specification reveals that the training phase is for preselecting association criteria used for linking. The test for compliance with the written description requirement is whether the added claimed subject matter is inherent in the written description. See *Schering Corp. v. Amgen Inc.*, 222 F.2d 1573 (Fed. Cir. 1987). The Examiner's conclusion is based on a search for *ipsis verbis* support, and not as a review of what the specification and its numerous examples would have taught those skilled in the art.

Similarly, the claim language "such that the key indexes the entry for retrieval thereof" is inherent in the claim language and the written description because indexing is inherently used for retrieval of information. For example, page 36, lines 22-25 states that the

key identifies an entry stored in persistent storage. Why would the entry be stored if not for retrieval?

Claims 4 and 34-35 have been cancelled, thus mooted the rejection of those claims.

With respect to claim 6, lines 5-6, even though there may not be *ipsis verbis* support for that language, the claimed subject matter is clearly supported by the originally filed written description. For example, see pages 6-8.

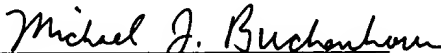
With respect to claim 8, lines 4-5 the limitation is inherent in the written description at pages 6-8. The function is defined at page 12, lines 14-15.

Applicant maintains its arguments regarding the rejection under 35 U.S.C. section 101 in the brief of March 4, 2004. Applicant further points out that the broad scope of the statute cannot be negated by a reference to the Manual of Patent Examination Procedure, which has no force of law. The Office Action cites no legal authority for its conclusion of non-statutory subject matter and should therefore be withdrawn.

Applicant further reasserts its arguments made in prior amendments, responses and briefs regarding the rejections under 35 U.S.C. section 102 for anticipation by the cited Platt patent.

In view of the foregoing, Applicant respectfully requests that the amendment be entered in order to place the application in better form for appeal and that the rejections be withdrawn.

Respectfully submitted,


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I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, this August 29, 2005.


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